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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/744,002	08/02/2001	Stephen Anderson	RU-0115	4899

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EXAMINER

FREDMAN, JEFFREY NORMAN

ART UNIT PAPER NUMBER

1637

DATE MAILED: 08/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/744,002

Applicant(s)

ANDERSON ET AL.

Examiner

Jeffrey Fredman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Status

1. The current application was returned by the BPAI after an affirmance in part decision. The decision indicated that rejections II-VII were affirmed (see page 16 of BPAI decision) and rejection I was reversed. Claims 1-13 were appealed. So rejections regarding claims 1-11 and 13 were affirmed and these claims are closed for further prosecution, in accordance with MPEP 1214.06(III) and the previous grounds of rejection are maintained as affirmed by the BPAI and not appealed to the Federal Circuit. These claims are therefore no longer pending in this application and are cancelled.

2. Claim 12 is the sole claim in the 102(b) rejection which was reversed by the BPAI. This claim will therefore be treated below with additional evidence presented to address the elements argued by the BPAI.

Priority

3. Claim 12 does not receive benefit of priority to the parent application 09/181,601 because the parent lacks descriptive support for the new element of "NOESY-assign process" of the current specification, as far as the examiner can determine. The examiner reviewed the parent application, and could not find basis for this limitation in the specification of 09/181,601.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 12 is rejected under 35 U.S.C. 102(b) as being anticipated by the University of Texas at Galveston campus as evidenced by Mumenthaler et al (J. Mol. Biol. (1995) 254:465-480) and an email from Dr. Werner Braun (August 15, 2005)(attached).

6. The examiner takes official notice that one year before the filing date of this application, the University of Texas at Galveston campus comprised a computer, an NMR facility which had a spectrometer, data collection device, and computer algorithms to analyze the NMR spectra and determine the tertiary structure of the proteins including the NOAH program for automated assignment of NOESY spectra, as well as laboratories for expressing proteins, access to the Wisconsin programs which can parse target polynucleotides, and internet access to the Protein Data Bank and the DALI webserver.

The BPAI specifically challenged at page 9 of the decision:

"Here, the examiner has not pointed to any section(s) in Mumenthaler which teach (i) a lab for expressing the putative domain of an unknown protein as set forth in subpart (B); (ii) a database as recited in subpart (H); and (iii) a fourth computer as required by subpart (1), of claim 12. As highly likely as it may be that the university does in fact have the referenced laboratory, database and computer, we remind the examiner that an anticipation rejection must be based on substantive evidence, not

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speculation. Since we do not find, and the examiner has not pointed out, any teachings in Mumenthaler of a laboratory for expressing protein domains (B), a database which stores the structure and function of known proteins (H), and a computer capable of determining the structural homology between the three dimensional structure of an unknown protein and a known protein (1), we do not find that it (Mumenthaler) anticipates the subject matter of claim 12."

The elements argued by the BPAI as absent in the rejection are met by the email from Dr. Braun. Dr. Braun notes that UTMB had a laboratory that could express protein in 1995, internet access to the protein databank at Brookhaven National Laboratory, and a computer algorithm capable of determining 3D structural homology between the known and unknown proteins as discussed in his email. This provides express evidence that the university had the referenced laboratory, database and computer.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Fredman whose telephone number is (571)272-0742. The examiner can normally be reached on 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on (571)272-0782. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jeffrey Fredman
Primary Examiner
Art Unit 1637

8/17/08

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